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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,993

02/05/2004

Robert Taft

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23628 7590 08/06/2009  
WOLF GREENFIELD & SACKS, P.C.  
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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

08/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,993	<b>Applicant(s)</b> TAFT ET AL.	
	<b>Examiner</b> JAMISUE A. PLUCINSKI	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 10,12-17 and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9,11 and 18-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050310</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Claims 1-9, 11 and 19-29 in the reply filed on 5/11/09 is acknowledged.
2. It should be noted that there was a typographical error in the Election/Restriction, it stated that Invention I was Claims 1-28, when in fact it should have said Claims 1-29. Therefore Claim 29 is being considered along with the other claims elected.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 19, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by The Jackson Laboratory ([www.jax.org](http://www.jax.org)).
5. With respect to Claims 1 and 19: The Jackson Laboratory discloses the use of a business which performs a method of providing a plurality of mouse colony management services to customers (See Page 3) comprising:
  - a. Receiving an order from a customer that indicates a service desired (see Page 8, Customer Service and Ordering);

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- b. Providing the plurality of services to the customer by utilizing a core process and optionally a service-specific process, whereby the core process is shared by a plurality of services (See Related Services, Page 3).
- 6. With respect to Claim 2: See Page 5.
- 7. With respect to Claim 27: The Jackson Laboratory discloses the use of a system for providing a plurality of mouse services comprising a customer module (Page 8), a surgery and invitro module as well as a cryo-preservation module (See Pages 3 and 4). With respect to the limitation "wherein the plurality of mouse management services are provided to customers by utilizing a combination of at least four of these modules" is considered to be intended use of the system. Furthermore, the system only requires three of the modules, therefore how can four then be utilized?
- 8. With respect to Claim 28: The Jackson Laboratory offers information which is all found on a website and discloses the use of education. Therefore the examiner considers the system to be computer implemented.
- 9. With respect to Claim 29: This claim is rejected as being directed to an unselected species of the Markush group in Claim 27, the live animal module was not selected as one of the three modules of Claim 27.

***Claim Rejections - 35 USC § 103***

- 10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-9, 11 and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Jackson Laboratory.

12. With respect to Claims 3, 8, 20 and 25: Jax discloses (page 13) that the laboratory operates a frozen mouse embryo repository which preserves important stocks and strains of mice and upon request the strains can be thawed and carried to full term by foster mothers. This indicates the breeding services are a form of IVF. The claims are directed to ordering and providing services, not a new in-vitro fertilization method. Therefore whatever method used to produce the embryo and breed the mouse is considered to be non-functional descriptive material, due to the fact that the actual steps of receiving an order and providing services are performed the same regardless of the specific method of in-vitro and what stage the embryo is harvested. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

13. With respect to Claims 4 and 21: See Page 3.

14. With respect to Claims 5-7 and 22-24: See Page 4.

15. With respect to Claims 9 and 26: See Page 6.

16. With respect to 11: See Pages, 4 and 13.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629